

REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed August 7, 2001. Having addressed all objections and grounds of rejection, claims 1-20, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

The Examiner has rejected claims 1, 2, 6-8, and 16 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,004,276, issued to Wright et al (hereinafter "Wright") in view of U.S. Patent No. 5,673,256, issued to Maine (hereinafter "Maine"). This rejection is respectfully traversed because the Examiner has failed to present a *prima facie* case of obviousness as required by MPEP 2143 which states in part:

2143 Basic Requirements of a Prima Facie Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combi-

nation and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). rejection under 35 U.S.C. 103.

Thus, the Examiner is required to show: 1) motivation to make the alleged combination; 2) likelihood of success of the alleged combination; and 3) that all elements of the invention are found in the alleged combination. The Examiner has failed to make any of these three showings.

First, in a specious attempt to show motivation, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to schedule reports for delivery at some time in the future, since it is often advantageous to delay transmission of messages, data files or reports in order to minimize costs or to utilize the network during times of lower network loading, and therefore higher bandwidth availability (see col. 1, lines 13-16).

Though this indeed may be true for Maine, it would only be true because Maine communicates over dedicated satellite channels and does not communicate through a "publically accessible digital data communication network". There is no suggestion that Wright would have or should have any such notion of "minimizing costs or utilize the network during times of lower network loading". The cost of transmission over the Internet is not a function of the time of transmission. In fact, the Internet by its very nature has a control structure which is so decentralized, no peak

loading determination could even be made. Therefore, one of ordinary skill in the art would specifically not be motivated to consider Maine, because it provides no advantage.

Secondly, the Examiner has not even addressed "how" Wright and Maine could be combined. It is not known whether he suggests that Wright only communicate over a dedicated satellite link. This seems unlikely because Wright states at column 1, lines 7-10:

The present invention is directed to an improved object oriented information system for use in a hospital and more particularly for use by the cardiology and administrative departments of a hospital.

If Wright only communicates within a single department of a single hospital, it is not understood how the dedicated satellite channel would work.

Lastly, the Examiner has not shown that the alleged combination has all of the claimed elements. Neither Wright nor Maine has a "publically accessible digital data communication network". Wright employs a local network within the hospital and Maine utilizes a dedicated satellite channel.

Neither has a "server" which spools anything. The Examiner has admitted that Wright does not. Maine, on the other hand, apparently stores messages for future delivery directly within the subscriber unit 26.

Thus, the Examiner has not made a *prima facie* case of obviousness with regard to the rejection of claims 1, 2, 6-8, and 16. Therefore, this rejection is respectfully traversed.

In his rejection of claims 2 and 7, the Examiner states, "... wherein said server electronically delivers ...". This statement is clearly erroneous, because it is subscriber unit 26 of Maine which generates, stores, and transmits messages. There is no separate server.

In rejecting claim 8, the Examiner fails to acknowledge that the claimed "repository" is located within the "server". Maine has no such server. In further support of his rejection, the Examiner references Wright, column 47, lines 19-65, which says nothing of where the report is stored, which is of the essence to the claimed element.

In making his further rejection of claims 3, 4, 9, 10, 17, and 18, the Examiner alleges motivation for the alleged three reference combination by stating:

It would have been obvious to one of ordinary skill in the art at the time of the invention to connect the plurality of user terminals to the server via the world wide web, since such networks enable information to be distributed to a wide range of people around the world while using communications protocols that are non-proprietary (see col. 1, lines 39-46).

Again, this attempt at motivation is particularly specious. Wright has as its purpose to communicate within a single

department of a hospital. Maine communicates world wide via dedicated satellite channel. It is disadvantageous for either Wright or Maine to employ a "publically accessible digital data communication network".

The Examiner has rejected claims 11-14 under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Maine and further in view of U.S. Patent No. 6,094,655, issued to Rogers et al (hereinafter referred to as "Rogers"). This rejection is respectfully traversed because the Examiner has failed to make a *prima facie* case of obviousness as required by MPEP 2143. Specifically, in alleging motivation, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to format a report in HTML, since this would make the report readable by a wide variety of users on a variety of platforms, HTML being the industry standard for formatting documents to be read by a web browser.

There is no showing the either Wright or Maine want their messages to be "readable by a wide variety of users". Both have private, dedicated networks. Wright is located within a single department of a hospital and Maine is transmitting over a dedicated satellite channel. It would be disadvantageous for either of these systems to make their messages more broadly readable by third parties.

The Examiner surprisingly makes a similar statement in paragraph 21, stating:

It would have been obvious to one of ordinary skill in the art at the time of the invention to connect the plurality of terminals to the server via the world wide web, since such networks enable information to be distributed to a wide range of people around the world which using communications protocols that are non-proprietary.

Yet, it is clear that it is disadvantageous for Wright to distribute its medical information "to a wide range of people around the world". Wright is concerned with distribution within a single hospital department. Similarly, Maine is concerned with a dedicated point-to-point transmission. There is simply disutility in dissemination "to a wide range of people around the world".

In rejecting claims 5, 15, and 19, the Examiner suggests the further combinations involving Applicants' Background of the Invention. Yet, there is no suggestion for the combination or indication of how to accomplish the combination, except from Applicants' specification and drawings. Therefore, the rejections of claims 5, 15, and 19 are respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, as amended, being the only pending claims.

Respectfully submitted,

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By his attorney,

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